



Attorney's Docket No. P2248-472

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of )  
Gordon R. MEYER, et al. )  
Application No.: 09/074,544 )  
Filed: May 8, 1998 )  
For: METHOD FOR DYNAMICALLY )  
GENERATING A "TABLE OF )  
CONTENTS" VIEW OF A HTML- )  
BASED INFORMATION SYSTEM )

Group Art Unit: 2773

Examiner: B. Huynh

Appeal No. \_\_\_\_\_

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**REPLY BRIEF**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This Reply Brief is being filed in response to the Examiner's Answer dated October 23, 2001.

**Grouping of Claims**

In Section (7), page 2, the Answer asserts that Appellants' Substitute Brief states that "the remaining claims, i.e., claims 6-7, 9, 13-14, 29-30, 32, 36-37, 46-47, 49, 53-54, 57, 58 and 2-5, 16-23, 25-28, 39-45, 60-61, stand or fall together as a group however provided two different arguments for the claims." Appellants respectfully submit that the Answer's assertion that "claims 6-7, 9, 13-14, 29-30, 32, 36-37, 46-47, 49, 53-54, 57, 58 and 2-5, 16-23, 25-28, 39-45, 60-61, stand or fall together as a group" is incorrect.

According to 37 C.F.R. 1.192(c)(7),

[f]or *each* ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone *unless* a statement is included that the claims of the group do not stand or fall together and, in the argument [section of the brief] . . . ,

appellant explains why the claims of the group are believed to be separately patentable. [37 C.F.R. 1.192(c)(7) (emphasis added)]

As noted in the Substitute Brief and in the Answer, there are two grounds of rejection under consideration in the present Appeal: claims 6-15, 29-38 and 46-59 were rejected under 35 U.S.C. § 102(e); and claims 2-5, 16-23, 25-28, 39-45 and 60-61 were rejected under 35 U.S.C. § 103(a).

For the *first* ground of rejection under § 102(e), Appellants stated in the Substitute Brief that "Appellants do not consider all of the claims that are rejected under 35 U.S.C. § 102(e) to stand or fall together." [Substitute Brief, Section VII, page 5, "Grouping of Claims"] Appellants then stated in the Substitute Brief that each of the following groups of claims present separate issues for patentability: claims 8, 31 and 48; claims 10, 33 and 50; claims 11, 34 and 51; claims 12, 35 and 52; claims 15, 38 and 59; and claims 55 and 56. Accordingly, in compliance with 37 C.F.R. 1.192(c)(7), Appellants provided separate arguments for patentability for each of these groups of claims. [*see* Appellants' Arguments VIII.E, VIII.F, VIII.G, VIII.H, and VIII.I, respectively]

Appellants further stated that the remaining claims rejected under 35 U.S.C. § 102(e), i.e., claims 6-7, 9, 13-14, 29-30, 32, 36-37, 46-47, 49, 53-54, 57, 58, "can be treated as a single group for purposes of this appeal." [Substitute Brief, Section VII, page 5, "Grouping of Claims"] Thus, Appellants consider claims 6-7, 9, 13-14, 29-30, 32, 36-37, 46-47, 49, 53-54, 57 and 58 to form a single group for purposes of this Appeal. Accordingly, in compliance with 37 C.F.R. 1.192(c)(7), Appellants provided a separate argument for patentability for this group of claims. [*see* Appellants' Argument VIII.C]

For the *second* ground of rejection under § 103(a), Appellants stated that all of the claims rejected under 35 U.S.C. § 103(a), i.e., claims 2-5, 16-23, 25-28, 39-45, 60-61, "can be treated as a single group for purposes of this appeal." [Substitute Brief, Section VII, page 5, "Grouping of Claims"] Accordingly, Appellants consider claims 2-5, 16-23, 25-28, 39-45, 60-61 to form a single, yet separate, group for purposes of this Appeal. Accordingly, in compliance with 37 C.F.R. 1.192(c)(7), Appellants have provided a

separate argument for patentability for this group of claims. [*see* Appellants' Argument VIII.J]

Therefore, for the foregoing reasons, it is respectfully submitted that the assertion made in the Answer that "claims 6-7, 9, 13-14, 29-30, 32, 36-37, 46-47, 49, 53-54, 57, 58 and 2-5, 16-23, 25-28, 39-45, 60-61, stand or fall together as a group" is incorrect.

#### **The DeRose Reference**

In Section (11), page 4, the Answer presents a new argument that according to the DeRose et al. patent (U.S. Patent No. 6,055,544, hereinafter "DeRose"), "[v]ery large documents, such as the operation manuals for large system, *are equivalent to a help folder containing a hierarchy of sub-folders and files*. The manual includes volumes, chapters, section, and paragraphs . . . , *which are equivalent to books and files within the operation manual folder*." [Answer, Section (11), page 4 (emphasis added)]. Thus, the Answer now concludes that DeRose discloses "the retrieving and displaying of any selected portion of a document from a group of related documents in an operation manual help folder." [Answer, Section (11), page 4 (emphasis in original)]. Appellants respectfully submit that the Answer's new characterization of DeRose is incorrect.

DeRose discloses a method of using meta-tags inserted into large electronic documents to provide easier retrieval and access to selected portions of the document over remote connections. [See DeRose, col. 11, lines 27-31] According to DeRose, a table of contents can be generated for a particular electronic document from the meta-tags that have been inserted into the electronic document. [See DeRose, col. 17, line 60 - col. 19, line 22] The table of contents for that electronic document can include the chapters, sections, pages, and so forth contained within the electronic document. FIG. 3 of DeRose illustrates the hierarchical structure of the elements associated with the meta-tags inserted into an example document. [See DeRose, col. 8, lines 27-45] Thus, the meta-tags define the structure of *the document* (chapters, sections, and so forth), and not a file structure comprised of individual data files. The table of contents that is created for the document using the inserted meta-tags allows a user to select a given part or portion of *the document*. [See DeRose, col. 19,

lines 46-49] DeRose delimits an electronic document into smaller, self-contained document fragments to allow easy access to only a portion of the document. By making a selection from the table of contents, a user is able to download only the needed portion of the document, not the entire document. DeRose organizes the document in such a manner specifically to *eliminate* the need to generate numerous small files with hyperlinks between them. [See DeRose, col. 5, lines 54-55; col. 21, lines 45-47]

Contrary to the Answer's assertion, the volumes, chapters, sections, paragraphs and so forth are not equivalent to books and files within the operation manual folder, as DeRose clearly teaches away from the use or generation of individual data files. As disclosed by DeRose,

it is a general aim of the invention to provide a mechanism for accessing only a portion of a large electronically published document, and to automatically determine what portion of the document to select as a previous portion or a next portion *without maintaining separate data files of each portion of the document*. DeRose, col. 4, lines 34-39.

Thus, organizing an electronic document into separate, individual data files goes directly against the express objective of DeRose. Rather, DeRose delimits the file into individual portions using meta-tags inserted into the document. The user then accesses those portions through the table of contents. However, DeRose does not decompose the electronic document into separate data files. Thus, it is respectfully submitted that DeRose does not disclose or suggest that very large documents "are equivalent to a help folder containing a hierarchy of sub-folders and files" and does not disclose or suggest that the volumes, chapters, sections, and paragraphs "are equivalent to books and files within the operation manual folder." [Answer, Section (11), page 4]

Furthermore, the Answer does not identify in DeRose where support is provided for the assertions that "very large documents . . . are equivalent to a help folder containing a hierarchy of sub-folders and files" and that the volumes, chapters, sections, and paragraphs of the operation help manual discussed in DeRose "are equivalent to books and files within the operation manual folder." [Answer, section (11), page 4] Furthermore, no citation to DeRose is made to support the Answer's new conclusion that DeRose is directed to "the

retrieving and displaying of any selected portion of a document from a group of related documents in an operation manual help folder." [Answer, Section (11), page 4 (emphasis in original)]. It is respectfully submitted that these new assertions are without support in the reference, and, therefore, these arguments are incorrect characterizations of DeRose based on hindsight analysis.

According to M.P.E.P. § 2142, "[t]o reach a proper determination under 35 U.S.C. 103, . . . impermissible hindsight must be avoided and the legal conclusion [of obviousness] must be reached on the basis of the facts gleaned from the prior art." Furthermore, according to M.P.E.P. § 2143.01, "[t]he mere fact that references can be . . . modified does not render the resultant combination obvious unless the prior art also suggests the desirability of [such modification]." [citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)] It is respectfully submitted that no support exists within DeRose for the conclusion that DeRose is directed to retrieving and displaying selected portions of an electronic document from a group of separate, but related, data files. Consequently, since the Answer does not identify where DeRose discloses the use and generation of separate data files, it is respectfully submitted that the Answer's assertions and conclusions are founded upon "knowledge gleaned only from applicant's disclosure." [see M.P.E.P. § 2145] Since DeRose expressly teaches away from the generation of separate data files, it is respectfully submitted that there is no disclosure in the reference to employ DeRose to implement the present invention. Consequently, it is respectfully submitted that the Answer's new arguments entail hindsight and are, therefore, incorrect and improper.

#### **Appellants' Argument VIII.C**

In section (11), page 5, the Answer presents the new assertion that "it appears that the appellants are equating DeRose's teaching of 'very large operation manual' as a single book instead as a help folder containing a hierarchy of sub-folders of books and files." [Answer, section (11), page 5] Additionally, the Answer concludes that "DeRose clearly teach the indexing of each file and book of the operation manual folder for files of a first

type." [Answer, section (11), page 5] It is respectfully submitted that the Answer's new characterization of DeRose is incorrect.

As discussed previously, by using meta-tags inserted into an electronic document, DeRose delimits an electronic document into smaller, self-contained documents fragments to allow easy access to only a portion of the document. However, DeRose does not decompose the electronic document into separate data files. It is respectfully submitted that DeRose's teaching of a "very large operation manual" is an example of a single electronic document into which meta-tags have been inserted, so that this document can be delimited into smaller portions to facilitate retrieval of those portions. DeRose does not decompose the "very large operation manual" into the equivalent of a help folder containing a hierarchy of sub-folders of books and files. The hierarchy disclosed by DeRose is a hierarchical structure of the elements associated with the meta-tags inserted into a particular document. [See DeRose, FIG. 3 and col. 8, lines 27-45] Decomposing an electronic document into separate data files goes against the express objective of DeRose. [See DeRose, col. 4, lines 34-39] Since, DeRose does not use or generate separate data files for a particular document, it is respectfully submitted that DeRose does not "clearly teach the indexing of each file and book of the operation manual folder for files of a first type." [Answer, Section (11), page 5]

In addition, it is respectfully submitted that DeRose does not disclose "indexing *each file and book of a predetermined folder for files of a first type*", as recited in claims 2, 6, 20, 25, 29, 42 and 46, or "scanning *plural files ... to identify files of a first type*", as recited in claim 57. As discussed previously, the new assertion presented in the Answer that "the operation manual is a help folder which contains a group of documents represented by volumes, chapters, sections, *files*" is incorrect. DeRose does not decompose an electronic document into separate data files, but, rather, delimits portions of an electronic document by using meta-tags inserted into the document. Since DeRose does not use or generate separate data files, DeRose does not disclose a need to scan for files to retrieve information residing outside of an individual document. The information needed by DeRose to delimit the electronic document into portions is contained within the

electronic document itself in the form of the embedded meta-tags. Therefore, it is respectfully submitted that DeRose does not disclose "indexing each file and book for files of a first type" as alleged in the Answer.

#### **Appellants' Argument VIII.E**

In section (11), page 7, the Answer presents the new assertion that DeRose teaches the generation of a table of contents based on a multi-file system, because "DeRose's operating manual help folder is a multi-file system wherein each file (volume, chapter, section, paragraph) within the folder is scanned for generating the table of contents." [Answer, section (11), page 7] It is respectfully submitted that the Answer's new characterization of DeRose is incorrect.

As discussed previously, by using meta-tags inserted into an electronic document, DeRose delimits an electronic document into smaller, self-contained documents fragments to allow access to only a portion of the document through a table of contents. However, DeRose does not decompose the electronic document into separate data files, as this would go against the express objective of DeRose. [See DeRose, col. 4, lines 34-39]. The volumes, chapters, sections, and so forth are merely delimited portions of the document (i.e., self-contained document fragments) that are accessed through a table of contents. The portions of the electronic document are not separate data files. It is respectfully submitted that DeRose's operating manual is not the equivalent of a help folder, nor is it a multi-file system. The operating manual disclosed by DeRose is merely an example of a document that has been internally delimited (through the use of embedded meta-tags) in such a manner as to facilitate the retrieval of individual portions of the document. The operating manual is not decomposed into separate data files. Since DeRose does not disclose a multi-file system, but instead teaches away from the use of a multi-file system, it is respectfully submitted that DeRose does not teach the generation of a table of contents based on a multi-file system.

**The Walls et al. Reference**

In section (11), page 9, the Answer continues to present the new argument that DeRose's teaching of a "large operation manual having volumes, chapters, sections is equivalent to a help folder having separate files and books." [Answer, Section (11), page 9] Consequently, the Answer argues that "[i]t would have been obvious to one of skilled in the art, at the time the invention was made, to combine Walls' teaching of generating an up-to-date table-of-content to DeRose." [Answer, Section (11), page 9] It is respectfully submitted that the Answer's new characterization of DeRose is incorrect and, therefore, one of ordinary skill in the art would not be motivated to combine the teachings of DeRose with the teachings of Walls.

As discussed previously, DeRose does not decompose the electronic document into separate data files, as this would go against the express teachings of DeRose. [See DeRose, col. 4, lines 34-39]. The volumes, chapters, sections, and so forth are merely delimited portions of the document (i.e., self-contained document fragments) that are accessed through a table of contents. The portions of the electronic document are not separate data files. Therefore, it is respectfully submitted that the large operation manual having volumes, chapters, sections and so forth is not "equivalent to a help folder having separate files and books." [Answer, Section (11), page 9] Consequently, since DeRose specifically teaches away from the use of multiple data files, one of ordinary skill in the art would not be motivated to modify the system of DeRose in a manner that goes against the express teachings of DeRose. Since the teachings of DeRose and Walls are directed to disparate objectives, and in fact are contrary to each other, it would not have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teachings of DeRose and Walls (or DeRose and any other teaching which suggests the use of a multi-file system).



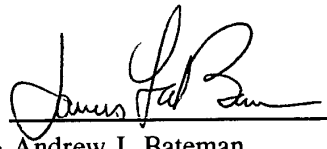
**Conclusion**

In summary, it is respectfully submitted that the Answer fails to identify any disclosure in DeRose directed to the use or generation of separate data files. At best, DeRose discloses that a particular electronic document can be delimited into smaller portions using meta-tags embedded into the document. However, these document portions or fragments are self-contained within the document itself and do not form separate data files. The "very large operational manual" disclosed by DeRose is not equivalent to a help folder containing a hierarchy of sub-folders of books and files, nor are the volumes, chapters, sections, and so forth of the "very large operational manual" equivalent to books and files contained within a help folder. Therefore, it is respectfully submitted that DeRose does not disclose Appellants' invention.

The remaining points raised in the Examiner's Answer are believed to be adequately addressed in Appellants' Substitute Brief. For the reasons set forth in that Brief, as well as the additional reasons presented herein, the rejections of the claims are not properly founded in the statute, and should be reversed.

Respectfully submitted,

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Date: December 26, 2001